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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,633	01/10/2002	Akio Kobayashi	111632	6574
25944 7590 02/26/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
SHAY, DAVID M				
ART UNIT		PAPER NUMBER		
3735				
MAIL DATE		DELIVERY MODE		
02/26/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/041,633

Applicant(s)

KOBAYASHI ET AL.

Examiner

david shay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 26, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-10,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant has submitted new drawings. These drawings are accepted.

With regard to the art rejection, applicant argues that Kubota does not disclosed the claimed energy densities, because Kubota discusses the use of 2.54 j/cm^2 , referring to the examiner's attribution thereto of the teaching of 50 to 250 mJ/cm^2 as a "misinterpretation". The examiner must, respectfully disagree. The Kubota reference uses 213 nm radiation, and gives the 2.54 j/cm^2 in the context of using that radiation, Kubota goes on to note that this energy density-wavelength combination provides the same speed of tissue removal as the energy density-wavelength combination of 50 to 250 mJ/cm^2 at 193 nm. Thus it is clear that these two sets of parameters are equivalent for the purposes of operating on cell walls.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 5-10, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abela et al ('982) in combination with Matsuura et al (1998), Kubota et al, and Lewis et al. Abela et al ('982) teach the method as claimed except for the specific recitation of the use of a hollow fiber, the specific laser energies, or the quartz chip (please note that the absence of the quartz chip implies the absence of other structures predicated thereon, such as the hydroxide groups). Matsuura et al (1998) teaches forming hollow waveguides for the delivery of excimer laser light from hollow fibers that are coated with aluminum and are filled with an inert gas. Lewis et al teaches the desirability of using a wave guiding device with a tapered tip in a medical system and method for applying high energy radiation. Kubota et al teach that producing holes in cell walls can be done using energy densities between 50 and 250 mJ/cm^2 with 193 nm light (see column 5, line 17-23). Lewis et al teach the desirability of providing a tapered structure on

the distal end of a hollow optical fiber delivering 193 nm radiation. It would have been obvious to the artisan of ordinary skill to employ a device and method as taught by Abela et al ('982) in the device and method of Matsuura et al (1998) since Matsuura et al (1998) specifically discloses the desirability of using hollow waveguides in medical applications; or to use the device and method of Matsuura et al (1998) in the device and method of Abela et al ('982), since Abela et al ('982) disclose no particular fibers and since these fibers efficiently transmit high energy radiation while exhibiting favorable bending radii; and in either case to employ the tapered tip of Lewis et al, since this provides beam sizes in the range required by Abela et al ('982); or to employ the tapered tip of Lewis et al on the waveguide of Abela et al ('982), since this provides beam sizes in the range required by Abela et al ('982), or to employ the device and method of Abela et al ('982) in the device and method of Lewis et al, since Lewis et al disclose drilling through cell walls as a preferred use of the device, and in either case to employ the hollow waveguide of Matsuura et al (1998), since this allows for the transmission of greater energies and avoids the formation of color centers, which is a problem, as taught by Lewis et al; or to provide the method and device of Lewis et al in the method and device of Matsuura et al (1998), since the tapered tip of Lewis et al provides greater energies and or to provide the method and hollow waveguide device of Matsuura et al (1998) in the device and method of Lewis et al, since this would avoid the production of color centers and enable larger energies to be delivered, and in either case to employ the method and device of Abela et al since this is a medical method as suggested by Matsuura et al (1998), which would benefit from the delivery of high energy radiation and since this device and method is useful for drilling into cell walls, as taught by Lewis et al; and in any case, to apply laser energy density in the range claimed, since can be used

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to produce holes in cell walls, as taught by Kubota et al; to employ a chip as claimed, since this condenses the light and is commercially available, as taught at paragraph [0051] of the instant disclosure; to use any of the claimed inert gasses, since these are all well known inert gasses in the art, are not critical and provide no unexpected result, thus producing a method such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5-10, 13 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,132,289. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or

narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Applicant's arguments filed November 26, 2007 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/
Primary Examiner, Art Unit 3735